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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/666,374	09/20/2000	Thomas F. DeRosa	D#00013 (538-44)	6175

7590

11/14/2002

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EXAMINER

MEDLEY, MARGARET B

ART UNIT	PAPER NUMBER
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1714

9

DATE MAILED: 11/14/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/666,374

Applicant(s)

DEROSA ET AL.

Examiner

Margaret B. Medley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2002 and 05 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 14, 17-25, 27 and 30-37 is/are rejected.
- 7) ☒ Claim(s) 11-13, 15, 16, 26, 28 and 29 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☒ Interview Summary (PTO-413) Paper No(s). 7.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) ☐ Other: _____

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DETAILED ACTION

The rejections under 35 U. S. C. 112, second paragraph and the 35 U. S. C. 103 (a) are withdrawn in view of applicants' amendments to the claims and arguments made or record.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-10, 14, 17-25, 27 and 30-37 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Ahmed 6,074,445.

Ahmed teaches a method for operating an engine, a method for reducing friction in an engine, see example 4 of column 10, and a fuel composition comprising a hydrocarbon fuel containing preferably about 25 to about 40 % by volume of a fuel grade alcohol, e. g. ethanol, see column 6, line 60 to column 7, lines 1-2 and 18-22 and including oxygenated gasoline and diesel fuels, see examples 1 and 2 of columns 7 and 8, and an additive comprising a Superamide of an alkyl ester of a fatty acid and an alcohol amine, see column 4, lines 15-23, a higher alcohol and an ethoxylated fatty acid, see examples 1 and 2 of columns 7-8. Patentee further includes a co-solvent e.g. MTHF, see column 7, lines 1-17. The methods and fuel compositions of Ahmed anticipates instant claims 1-8, 10, 17-25 and 30-37.

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Ahmed further teaches that the additive may be mixed with a known oxygenated fuel in a volumetric ratio of about 1-1000 to about 1-100, see the bridging paragraph of columns 5-6, that anticipates instant claims 9, 14 and 27.

Patentee clearly does not teach the addition of MTBE as the oxygenated additive in its fuel composition and therefore anticipates the instant claims requirement that the fuel compositions and methods to be substantially free of MTBE.

The open-ended language "comprising" of the instant claims would not exclude the fatty acid additives of Ahmed from the instant claims compositions and methods.

Instant claims 11-13, 15-16, 26 and 28-29 appear to contain allowable subject matter over the prior art made or record.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-37 remain provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-40 of co-pending Application No. 09/708,237. Although the conflicting claims are not identical,

they are not patentably distinct from each other because of reasons made of record in Paper No. 5 dated 22 May 2002.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicant's arguments with respect to claims 1-37 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments filed 29 August 2002 have been fully considered but they are not persuasive. The double patent rejection is maintained for reason made of record in Paper No. 5 dated 22 May 2002. The terminal disclaimer is required once the application matures into a Patent and in the event that the Patents are not maintained by the same assignee for example in the event that one of the Patent may be sold to another assignee or company during the life of the Patent.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret B. Medley whose telephone number is 703-308-2518. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


Margaret B. Medley
Primary Examiner
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Margaret B. Medley
November 13, 2002